Peko Wallsend Operations Ltd & Ors v Linatex Process Rubber Bhd and another action

HIGH COURT (KUALA LUMPUR) — SUIT NO D2–22–1357 OF 1991 (CONSOLIDATED WITH SUIT NO D5–22–1515 OF 1991)
SITI NORMA YAAKOB J
22 FEBRUARY 1993

Copyright *— Copyright protection — Engineering drawings and three-dimensional works — Whether eligible for copyright protection — Copyright Act 1987 ss 3 & 7*

Copyright *— Infringement — Whether copying by way of 'reverse engineering' was an infringement of copyright — Copyright Act 1987 ss 13(1)(a) & 36(1)(a)*

Copyright *— Infringement — Whether copyright owner in engineering drawings and three — dimensional works may enforce his rights under the provisions of the Copyright Act 1987 — Copyright Act 1987 ss 3, 13, 32 & 37*

Copyright *— Copyright protection — Whether works may enjoy copyright protection in Malaysia although such works may not enjoy such protection under laws of country of origin — Copyright Act 1987 s 59A — Copyright (Application To Other Countries) Regulations 1990*

Civil Procedure *— Costs — Determination of costs to follow the event*

Words and Phrases *— 'Artistic work' — Copyright Act 1987 s 3*

Words and Phrases *— 'Reverse engineering'*

Two consolidated suits were brought by the plaintiffs, who are Australian-based companies, against the defendant, a company incorporated in Malaysia, for the enforcement of copyright in certain artistic works relating to pumps known as 'slurry pumps' which are designed, manufactured and distributed by the plaintiffs worldwide. In the lead action, the plaintiffs alleged that the defendant were reproducing slurry pump parts which were copies of the plaintiffs' slurry pump parts and engineering drawings of the same, with the intention to distribute their products by sale to the public. In the other action, the plaintiffs alleged that the defendant were reproducing certain moulds identical to the moulds used by the plaintiffs to make the slurry pump parts. The plaintiffs contended that they had not given their consent or licence to the defendant to copy, reproduce or manufacture any slurry pump parts or mould and any attempt by the defendant to indirectly copy, reproduce or manufacture any pump part or mould by a process known as 'reverse engineering' was an infringement of the plaintiffs' copyright to such parts and moulds and the three-dimensional form of the plaintiffs' slurry pump parts and moulds. In defence, the defendant pleaded that since they were not copying any

of the plaintiffs' engineering drawings to reproduce the pump parts and moulds, reproducing such pump parts and moulds by way of reverse engineering does not amount to an infringement of either the plaintiffs' copyright to the engineering drawings relating to the pump parts and moulds or the three-dimensional form of the plaintiffs' slurry pump parts and moulds. A

Pursuant to a consent order made under O 33 r 2 of the Rules of the High Court 1980, the plaintiffs referred nine questions of law as preliminary issues: B

(1) Are engineering drawings (two-dimensional) capable of being eligible for copyright under the Copyright Act 1987 ('the Act') as 'artistic works'? C
(2) Are the three-dimensional products of such engineering drawings (two-dimensional) also within the meaning of the Act?
(3) Do such three-dimensional works enjoy copyright in themselves, that is to say, in their three-dimensional form?
(4) Is the material reproduction of the whole of the three-dimensional works or a substantial part thereof through copying by way of 'reverse engineering' an infringement of the copyright in such engineering drawings (two-dimensional)? D
(5) Is the material reproduction of the whole of such three-dimensional works or a substantial part thereof through copying by way of 'reverse engineering' an infringement of copyright in such three-dimensional works? E
(6) Can the copyright owner of the copyright in such engineering drawings (two-dimensional) enforce his rights under the provisions of the Act in respect of such infringement under question (4)? F
(7) Can the copyright owner of the copyright in such three-dimensional products enforce his rights under the provisions of the Act in respect of such infringement under question (5)?
(8) Having regard to the provisions of the Copyright (Applications To Other Countries) Regulations 1990, can copyright subsist in work which is eligible for copyright under the provisions of the Act, if such work originated from a specified country, although such work may not enjoy copyright protection under the laws of that specified country? G
(9) Does such a work described in question (8) above enjoy the rights and protection provided under the Act? H

Held, determining all nine preliminary issues in the affirmative and making an order in favour of the plaintiffs:

(1) The court rejected the defendant's argument that engineering drawings have no artistic quality and do not qualify for copyright protection as artistic works within s 7 of the Act. Since s 3 of the Act does not qualify the type of drawings eligible for protection and the provisions are wide enough to include engineering drawings, there is no room to limit the protection by imputing into the I

definition of 'artistic work' a qualification that the drawings must possess some form of artistic quality.

(2) Copyright not only vests in the engineering drawings (two-dimensional) as 'artistic works' but has been extended and enlarged to cover the finished products (three-dimensional) as well and which have been manufactured from the drawings. It therefore follows that three-dimensional works enjoy copyright in themselves.

(3) 'Reverse engineering' is nothing more than a technique or process by which a product or a substantial part of that product, is reproduced by indirectly copying through inspecting and measuring the product or a substantial part of the product without sight of the drawings or blueprints relating to the product or a substantial part of the product. It is clear that direct copying of drawings or other forms of artistic work as defined by the Act is an infringement and enforceable under the Act. Since the Act makes direct copying an infringement, it is only right and proper that indirect copying is also an infringement, as to conclude otherwise would go against the intention of the legislature in enacting the Act as it did. It therefore also follows that any material reproduction by reverse engineering of the whole or substantial part of the three-dimensional works must amount to an infringement of the copyright in such three-dimensional works under s 36 of the Act.

(4) Applying the provisions of ss 3, 13 and 32 of the Act to the facts of the instant case, the plaintiffs as the copyright owners of the engineering drawings, are entitled to enforce their rights under s 37 of the Act when the defendant infringed the copyright to the engineering drawings and any three-dimensional work by reproducing identical slurry pump parts and moulds by way of reverse engineering.

(5) The Copyright (Applications To Other Countries) Regulations 1990 ('the Regulations') accords copyright protection to works that originate in countries which are members of the Berne Convention. Both Australia, the home of the plaintiffs, and Malaysia are members of the Berne Convention. The provisions of the Act have through the Regulations been extended to Australia as well and by virtue of this, any specific work which originates in Australia which is eligible for copyright if such work had originated in Malaysia, would enjoy copyright protection even though the local laws of Australia do not accord such protection in such works. It follows that works from a specified country which do not enjoy copyright protection in their country of origin, nonetheless is vested with such protection under the Act.

(6) The defendant argued that costs of the present application should be costs in the cause, as the nine questions were only raised as preliminary issues and the trial of the whole suit has not commenced. In rejecting the defendant's argument, the court considered that costs should follow the event and accordingly award costs to the plaintiffs in any event.

[Bahasa Malaysia summary

Dua tindakan guaman yang disatukan dibawa oleh plaintif, iaitu beberapa buah syarikat yang pusat operasi mereka di Australia, terhadap defendan, sebuah syarikat yang diperbadankan di Malaysia, untuk penguatkuasaan hakcipta dalam ciptaan seni yang tertentu yang berkaitan dengan pam yang dikenali sebagai 'slurry pumps' yang telah direkabentuk, dikilang dan diedarkan oleh plaintiff di seluruh dunia. Dalam tindakan utama, plaintif telah menuduh bahawa defendan menghasilkan semula bahagian slurry pump yang meniru bahagian slurry pump dan lukisan kejuruteraan slurry pump plaintif, dengan tujuan untuk mengedarkan hasil keluaran mereka tersebut secara jualan kepada orang ramai. Dalam tindakan yang satu lagi, plaintif menuduh bahawa defendan telah menghasilkan semula sejenis acuan yang tertentu yang serupa dengan acuan yang digunakan oleh plaintif untuk membuat bahagian slurry pump. Plaintif menegaskan bahawa mereka tidak memberi izin atau lesen kepada defendan untuk meniru, menghasilkan semula atau mengilang sebarang bahagian atau acuan slurry pump dan apa-apa percubaan oleh defendan untuk meniru atau mengilang sebarang bahagian atau acuan pam secara tidak langsung melalui proses yang dikenali sebagai 'reverse engineering' merupakan pelanggaran hakcipta plaintif ke atas bahagian dan acuan serta ciptaan tiga dimensi bahagian dan acuan slurry pump tersebut. Dalam pembelaan mereka, defendan berhujah bahawa oleh kerana mereka tidak meniru sebarang lukisan kejuruteraan plaintif untuk menghasilkan semula bahagian dan acuan pam, perbuatan defendan menghasilkan semula bahagian dan acuan pam dengan proses 'reverse engineering' tidak melanggar hakcipta plaintif ke atas lukisan kejuruteraan yang berkaitan dengan bahagian dan acuan pam atau ciptaan tiga dimensi bahagian dan acuan slurry pump tersebut.

Berdasarkan perintah persetujuan yang dibuat di bawah A 33 k 2 Kaedah-Kaedah Mahkamah Tinggi 1980, plaintif merujuk sembilan soalan undang-undang sebagai isu permulaan:

(1) Adakah lukisan kejuruteraan (dua dimensi) layak dilindungi oleh hakcipta di bawah Akta Hakcipta 1987 ('Akta itu') sebagai 'artistic works'?
(2) Adakah hasil keluaran tiga dimensi dari lukisan kejuruteraan tersebut (dua dimensi) juga dalam makna Akta itu?
(3) Adakah ciptaan tiga dimensi dilindungi oleh hakcipta iaitu dalam bentuk tiga dimensi?
(4) Adakah penghasilan semula material seluruh ciptaan tiga dimensi atau sebahagian besar daripadanya melalui tiruan secara 'reverse engineering' suatu pelanggaran hakcipta dalam lukisan kejuruteraan tersebut (dua dimensi)?
(5) Adakah penghasilan semula material seluruh ciptaan tiga dimensi atau sebahagian besar daripadanya melalui tiruan secara 'reverse engineering' suatu pelanggaran hakcipta di dalam ciptaan tiga dimensi tersebut?
(6) Bolehkah tuanpunya hakcipta di dalam hakcipta lukisan kejuruteraan (dua dimensi) menguatkuasakan haknya di bawah per-

untukan Akta itu berkaitan dengan pelanggaran hakcipta di dalam soalan (4)?

(7) Bolehkah tuanpunya hakcipta dalam hakcipta di dalam hasil keluaran tiga dimensi menguatkuasakan haknya di bawah peruntukan Akta itu yang berkaitan dengan pelanggaran hakcipta di dalam soalan (5)?

(8) Merujuk kepada peruntukan di bawah Peraturan-Peraturan Hakcipta (Pemakaian Ke Negara-Negara Lain) 1990, bolehkah hakcipta wujud di dalam ciptaan yang layak dilindungi hakcipta di bawah peruntukan Akta itu jika ciptaan tersebut berasal dari negara tertentu walaupun ciptaan tersebut mungkin tidak dilindungi hakcipta di bawah undang-undang negara yang berkenaan?

(9) Adakah ciptaan yang digambarkan di dalam soalan (8) di atas mendapat faedah dan perlindungan di bawah Akta itu?

Diputuskan, mengiakan kesemua isu permulaan dan membuat perintah memihak kepada plaintif:

(1) Mahkamah menolak hujah defendan bahawa lukisan kejuruteraan tidak mempunyai mutu seni dan tidak layak dilindungi hakcipta sebagai 'artistic works' dalam s 7 Akta itu. Oleh kerana s 3 Akta itu tidak menentukan jenis lukisan yang layak dilindungi dan peruntukan tersebut cukup meluas supaya termasuk lukisan kejuruteraan, tidak terdapat sebarang alasan untuk menghadkan perlindungan dengan mengaitkan dalam makna 'artistic work' suatu pembatasan bahawa lukisan mesti mempunyai mutu seni.

(2) Hakcipta bukan sahaja terletak hak pada lukisan kejuruteraan (dua dimensi) sebagai 'artistic works' tetapi juga telah diperluaskan dan diperbesarkan untuk meliputi hasil keluaran (tiga dimensi) yang dikilangkan daripada lukisan itu.

(3) 'Reverse engineering' tidak lebih daripada suatu teknik atau proses di mana suatu hasil keluaran atau sebahagian besar daripadanya dihasilkan semula secara tidak langsung melalui pemeriksaan serta ukuran hasil keluaran itu atau sebahagian besar daripadanya tanpa melihat lukisan atau pelan berkaitan dengan hasil keluaran itu atau sebahagian besar daripadanya. Adalah jelas bahawa tiruan secara langsung lukisan atau lain-lain jenis ciptaan seni seperti yang ditakrifkan dalam Akta itu dianggap sebagai pelanggaran hakcipta yang boleh dikuatkuasakan di bawah Akta itu. Oleh kerana Akta itu mensifatkan tiruan secara langsung sebagai pelanggaran hakcipta, maka adalah adil dan saksama bahawa tiruan secara tidak langsung juga disifatkan sebagai pelanggaran hakcipta kerana jika tidak, ini akan bertentangan dengan niat badan perundangan apabila menggubal Akta tersebut. Oleh itu, sebarang penghasilan semula material melalui 'reverse engineering' atas kesemua atau sebahagian besar ciptaan tiga dimensi mesti dianggap sebagai pelanggaran hakcipta dalam ciptaan tiga dimensi di bawah s 36 Akta itu.

(4) Menggunakan ss 3, 13 dan 32 Akta itu kepada fakta kes ini, plaintif sebagai tuanpunya hakcipta lukisan kejuruteraan itu, berhak

menguatkuasakan hak mereka di bawah s 37 Akta itu apabila defendan melanggar hakcipta lukisan kejuruteraan dan sebarang ciptaan tiga dimensi dengan menghasilkan semula bahagian dan acuan slurry pump yang sama melalui 'reverse engineering'.

(5) Peraturan-Peraturan Hakcipta (Pemakaian Ke Negara-Negara Lain) 1990 ('Peraturan itu') memberi perlindungan hakcipta kepada ciptaan yang berasal dari negara-negara yang menjadi ahli Berne Convention. Kedua-dua negara iaitu Australia, negara tempat bermastautin plaintif dan Malaysia adalah ahli Berne Convention. Peruntukan Akta itu melalui Peraturan itu telah diperluaskan ke Australia dan oleh yang demikian, sebarang ciptaan spesifik yang berasal dari Australia yang layak dilindungi hakcipta jika ianya berasal dari Malaysia, akan mendapat faedah perlindungan hakcipta walaupun undang-undang tempatan Australia tidak memberi perlindungan yang sedemikian kepada ciptaan tersebut. Ini bermakna bahawa ciptaan dari sebuah negara tertentu yang tidak mendapat faedah perlindungan hakcipta di negara asalnya, walaubagaimanapun diberi perlindungan hakcipta di bawah Akta itu.

(6) Defendan berhujah bahawa kos permohonan ini harus dibuat kos dalam kausa kerana kesembilan soalan itu hanya dirujuk sebagai isu permulaan dan perbicaraan keseluruhan guaman belum lagi dimulakan. Mahkamah menolak bantahan defendan atas alasan bahawa kos harus mengikut keadaan dan seterusnya memerintah supaya kos diberi kepada plaintif dalam apa-apa keadaan.]

[*Editorial Note*: The defendant has appealed to the Supreme Court vide Civil Appeal No 02–121–93.]

Notes

For cases on copyright, see 3 *Mallal's Digest* (4th Ed) paras 1639–1672.

Cases referred to

1 *British Northrop Ltd v Texteam Blackburn Ltd* [1974] RPC 57 (folld)
2 *LB (Plastics) Ltd v Swish Products Ltd* [1977] FSPLR 87 (folld)
3 *British Leyland Motor Corp Ltd & Anor v Armstrong Patents Co Ltd & Anor* [1986] 1 All ER 850 (distd)

Legislation referred to

Copyright Act 1987 ss 3, 7(2), 13, 36(1)(a), 37
Copyright Act 1956 [UK] s 3(5)(a)

Darryl Goon (*EH Lim* with him) (*Raja Darryl & Loh*) for the plaintiffs.
Vincent Lim (*Premalatha Kanesan* with him) (*Vincent Lim & Teoh*) for the defendant.

Cur Adv Vult

Siti Norma Yaakob J: Nine questions of law were argued before me as preliminary issues arising from two consolidated suits brought by the plaintiffs against the defendant to enforce their copyright in certain artistic works relating to a type of pump known as the 'slurry pump', which is designed, manufactured and distributed by the plaintiffs worldwide. Slurry pumps are mining equipment used to transport bulk materials such as coal, sand and gravel suspended in a fluid and flowing in a system of pipes.

The plaintiffs are Australian-based companies and in the lead action 1357, they allege that the defendant, a company incorporated in Malaysia, are reproducing slurry pump parts which are copies of the plaintiffs' slurry pump parts and engineering drawings of the same, with the intention to distribute their products by sale to the public. In the other action 1515, the plaintiffs allege that the defendant are reproducing certain moulds identical to moulds used by the plaintiffs to make the slurry pump parts.

It is the plaintiffs' case that they have not given their consent or licence to the defendant to copy, reproduce or manufacture any slurry pump part or mould and any attempt by the defendant to indirectly copy, reproduce or manufacture any pump part or mound by a process known as 'reverse engineering' is an infringement of the plaintiffs' copyright in the engineering drawings relating to such parts and moulds and the three-dimensional form of the plaintiffs' slurry pump parts and moulds.

In denying any wrongdoing, the defendant have pleaded that since they are not copying any of the plaintiffs' engineering drawings to reproduce the pump parts and moulds, reproducing such pump parts and moulds by way of reverse engineering does not amount to an infringement of either the plaintiffs' copyright in the engineering drawings relating to the pump parts and moulds or the three-dimensional form of the plaintiffs' slurry pump parts and moulds.

With that brief background as to what is actually in issue, I shall now turn to the nine questions that have been posed to me, three of which come under the heading of copyright, two under infringement, two more under enforcement and the last two under the Copyright (Application To Other Countries) Regulations 1990.

Copyright

Question 1: Are engineering drawings (two-dimensional) capable of being eligible for copyright under the Copyright Act 1987 as 'artistic works'?

Section 7 of the Copyright Act ('the Act') deals specifically with works that are eligible for copyright protection, and sub-s (1)(c) of the same section identifies artistic works as being one of such works.

Section 3 of the Act defines artistic work to include paintings, *drawings*, etchings, lithographs, woodcuts, engravings and prints and any three-dimensional work thereof. From this definition, it is clear that s 3 does not qualify the type of drawings eligible for protection and because of this, the plaintiffs contend that engineering drawings of the pump parts and moulds fall within the category of drawings and are, therefore, within the definition of artistic work under s 3 read together with s 7(1)(c) of the Act.

The defendant, on the other hand, argue that because drawings have been placed in the same category as paintings and other forms of fine art, there must be read into it an artistic quality to qualify to the meaning of artistic work. To that end, they contend that engineering drawings which have no eye appeal whatsoever, cannot be regarded as artistic works as by their very nature, they deal with shapes, configurations, dimensions and measurements which are contributed by the skill and labour of the design engineer and not by the draftsman.

Two cases concerning infringement of copyright of engineering drawings through the process of reverse engineering were cited to show just how the English courts deal with issues of this nature.

In *British Northrop Ltd v Texteam Blackburn Ltd*,[1] the plaintiffs were manufacturers of looms, the parts of which were made from mechanical drawings. The defendants copied certain parts of the plaintiffs' looms and marketed them as spare parts in competition with the spare parts manufactured by the plaintiffs. The court rejected the defendants' argument that no copyright existed in the plaintiffs' drawings on the ground that they were too simple to be original artistic works but held that copyright existed in the drawings and that the defendants were in breach of the copyright in that they had indirectly copied the drawings by copying the parts.

In *LB (Plastics) Ltd v Swish Products Ltd*,[2] the plaintiffs designed and manufactured a plastic knock-down drawer system of furniture known as the Sheerglide in accordance with production drawings which depicted the Sheerglide drawers. The defendants copied the Sheerglide drawers in producing their own version called the Swish design. The plaintiffs sued for breach of copyright of their production drawings. The trial judge held that the defendants had copied the shape of the plaintiffs' drawers and had, by indirect copying, infringed the plaintiffs' copyright in the production drawings of the drawers. The Court of Appeal reversed the decision of the trial judge, holding that it had not been established that the defendants had copied the drawers. The House of Lords restored the judgment of the trial judge, holding that on the evidence, copyright had been established.

These two cases are based on the United Kingdom Copyright Act 1956, where artistic work has been defined by s 3(1)(a), insofar as it relates to drawings, to mean the following, irrespective of artistic quality, namely paintings, sculptures, drawings, engravings and photographs. Incidentally, this English definition is very similar to the definition of artistic work contained in the Malaysian Copyright Act 1969, which has been repealed by the 1987 Act, and that the meaning of drawings in both the English Act and the repealed Malaysian Act is qualified by the phrase 'irrespective of artistic quality'. However, this qualifying phrase does not appear in the definition of artistic work in s 3 of our current Copyright Act 1987 and that has prompted the defendant to state that the English cases are not binding in that they were decided on a piece of legislation which is not in pari materia with ours.

It is true that the qualifying phrase 'irrespective of artistic quality' does not form part of the definition of artistic work in s 3 of our 1987 Act, but nonetheless, that same qualification has been redrafted and reappears as

A s 7(2), which reads as follows: 'Works shall be protected irrespective of their quality and the purpose for which they were created.'

In fact, the word 'artistic' no longer forms part of the qualifying phrase and neither can the purpose for which the works were created be questioned when the eligibility to copyright is being determined and by so enacting, Parliament must have intended to extend the scope of the protection to cover all types of drawings, regardless of their quality and the purpose of their creations.

In that respect, the definition and meaning of artistic work insofar as it relates to drawings under the Act is no more different than the English definition of artistic work under the UK statute and to that end, decisions by the English courts on the question of artistic works are persuasive, particularly where there is no reported local case on this point.

Since s 3 of the Act does not qualify the type of drawings eligible for protection and the provisions are wide enough to include engineering drawings, there is no room to limit the protection by imputing into the definition of artistic work a qualification that the drawings must possess some form of artistic quality. To do so would be contrary to the intentions of Parliament and to that end, considerations that the drawings must have eye appeal or whether anyone would choose to hang them in their living rooms, are irrelevant when determining whether such a drawing is eligible for protection.

I consider there is no uncertainty or ambiguity in the provisions of s 3 as to the meaning of drawings as a form of artistic work and for this and the other reasons which I have already stated, I answer Question 1 in the affirmative.

Question 2: Are the three-dimensional products of such engineering drawings (two-dimensional) also within the meaning of the Copyright Act 1987?

My reply to this question is a definite 'yes', as s 3 of the Act defines 'artistic work' to include 'drawings ... and any three-dimensional work thereof'. Thus under s 3, copyright not only vests in the engineering drawings (two-dimensional) as 'artistic work' but has been extended and enlarged to cover the finished products (three-dimensional) as well and which have been manufactured from the drawings.

It is interesting to note that under the repealed 1969 Act, the definition of artistic work under s 3 is only confined to the two-dimensional form of the various works mentioned by the section which is currently the law applicable under the English Copyright Act 1956.

Question 3: Do such three-dimensional works enjoy copyright in themselves, that is to say, in their three-dimensional form?

Consequent to my answers to Questions 1 and 2, it follows that such three-dimensional works enjoy copyright in themselves, as it is clear from s 3 that:

(1) engineering drawings (two-dimensional) are artistic works eligible for copyright; and

(2) that the three-dimensional works produced from the drawings are also eligible for copyright under the Act.

I therefore answer Question 3 in the affirmative.

Infringement

Question 4: Is the material reproduction of the whole of such three-dimensional works or a substantial part thereof through copying by way of 'reverse engineering' an infringement of the copyright in such engineering drawings (two-dimensional)?

'Reverse engineering' is nothing more than a technique or process by which a product or a substantial part of that product, is reproduced by indirectly copying through inspecting and measuring the product or a substantial part of the product without sight of the drawings or blueprints relating to the product or a substantial part of the product.

It is the defendant's contention that reproducing the plaintiffs' slurry pump parts and moulds through reverse engineering is not an infringement of the plaintiffs' engineering drawings relating to such parts and moulds, as the reproduction is done indirectly and not directly from the plaintiffs' engineering drawings. For this contention, they rely heavily on the dissenting judgment of Lord Griffiths in the case of *British Leyland Motor Corp Ltd & Anor v Armstrong Patents Co Ltd & Anor*.[3]

In that English case, the plaintiffs, a well-known car manufacturer, employed draughtsmen, who produced designs and engineering drawings for each component part of their Marina car. The same drawings were used by the plaintiffs to produce spare parts for their other models. The defendants were component manufacturers, who without the consent or licence of the plaintiffs, copied various spare parts of the plaintiffs' car by way of reverse engineering and sold the spare parts in competition with the plaintiffs. The plaintiffs brought an action against the defendants, claiming damages for breach of copyright and seeking an injunction restraining the defendants from infringing the plaintiffs' copyright in their drawings of various car components as exemplified by the exhaust system of the Marina car manufactured by the plaintiffs. The plaintiffs conceded that the exhaust system itself was not capable of being patented and that the designs and drawings on what it was based, were not registrable as registered designs but contended that the exhaust system itself was entitled to copyright protection.

The trial judge and the Court of Appeal upheld the plaintiffs' claim and the defendants appealed to the House of Lords on two grounds, firstly that copyright does not extend to the indirect reproduction of a functional article such as an exhaust pipe, which is not protected by patent law and which is not a registered design. Secondly, the plaintiffs cannot rely on their copyright to prevent the repair of a car supplied by the plaintiffs and requiring the inevitable replacement of a component part. In other words, the plaintiffs cannot enforce their right to maintain a monopoly in the supply of the component parts.

A On the first ground, the House of Lords by a majority of four to one, held against the defendants and ruled that the plaintiffs' exhaust system copied by the defendants by means of reverse engineering infringed the plaintiffs' copyright in the drawings because the copyright in the drawings extends to the reproduction of a purely functional object by means of indirect copying.

B On the second ground, the House was unanimous in holding that the plaintiffs' copyright was subject to the right of a purchaser, and any subsequent owner of a car manufactured by the plaintiffs, to keep their car in good repair and working order and for that purpose has access to a free market for spare parts for the car and by analogy with the principle of non-

C derogation of grant, the plaintiffs were not entitled to use the copyright in such a way as to maintain a monopoly in the supply of spare parts for their cars.

In dissenting as he did, Lord Griffiths held that the meaning of reproducing in s 3(5)(a) of the English Copyright Act 1956 should not be extended to include indirect copying but should be confined to its natural

D and true meaning. Section 3(5)(a) is worded as follows: 'The acts restricted by the copyright in an artistic work are reproducing the work in any material form; ...'.

The other factor which swayed the learned judge to decide as he did was the nature of the product that was reproduced. As it was only the plaintiffs'

E exhaust system, the copying of such a purely functional object which was not protected by patent law and which was not a registered design, should not be given the extended meaning of 'indirect copying'. The judge concluded that 'the scope of artistic copyright should be limited to the natural meaning of the provisions of s 3(5)(a), namely, direct copying including using the drawing to make the object it depicts'. It was for that reason that

F the defendant was held not to have infringed the copyright in the mechanical drawings by copying the exhaust pumps without seeing or receiving any assistance from the drawings.

Now how does our own Act deal with the question of 'reverse engineering'? Like the English Act, our current Copyright Act is also silent on the

G question of reverse engineering or indirect copying. Section 13(1)(a) of our Act makes reproduction in any material form of any artistic work or a substantial part thereof, either in its original or derivative form, an infringement. 'Reproduction' has been defined by s 3 to mean 'the making of one or more copies of work in any form or version and "reproducing" shall be construed accordingly'. Under s 36(1)(a), 'copyright is infringed by any

H person who does, or causes any other person to do, without the licence of the owner of the copyright, an act the doing of which is controlled by copyright under the Act'.

From these provisions, it is clear that direct copying of drawings or other forms of artistic work as defined by the Act, is an infringement and enforce-

I able under the Act. Since the Act makes direct copying an infringement, it is only right and proper that indirect copying is also an infringement, as to conclude otherwise would go against the intention of the legislature in enacting the Act as it did. This is so as unlike the English statute, copyright

in Malaysia has been extended not only to the two dimensional form of the product but also to the three dimensional form as well. This is clear from the definition of artistic work in s 3(a) of the Act. Such provisions are not found in the English statute, as only the two-dimensional works, and not the three-dimensional works, are eligible for protection. Thus there is no infringement of copyright of a three-dimensional work in England.

On the facts of the case before me, what is being alleged by the plaintiffs is that the defendant intend to reproduce an exact replica of the plaintiffs' slurry pump parts and moulds and although the method of reproduction is not by directly copying the engineering drawings of the parts and moulds but from the parts and moulds themselves, nonetheless such a method of reproduction is, I consider, an infringement of the copyright in such engineering drawings. This is so, as statutory protection has been vested not only in the engineering drawings but in the products manufactured from such drawings. Since direct copying or reproducing any material part of the engineering drawings or their product without the consent of the copyright owner amounts to infringement of the copyright to such engineering drawings or product, it follows that the copying or reproduction through the ingenuous method of reverse engineering must necessarily infringe the copyright in such engineering drawings. To conclude otherwise would give scant regard to the protection afforded by the Act. Since the essence of the infringement is the wrong done by copying or reproducing a product which is subject to statutory control either in its two-dimensional or three-dimensional form, the method adopted for such copying and reproduction cannot be questioned and narrowed to challenge the protection afforded by the Act.

On that conclusion, I also answer Question 4 in the affirmative.

Question 5: Is the material reproduction of the whole of such three dimensional works or a substantial part thereof through copying by way of 'reverse engineering' an infringement of the copyright in such three dimensional works?

Following my affirmative answer to Question 4 and from the clear meaning of s 3 of the Act extending copyright to three dimensional works as well, it follows that any material reproduction by reverse engineering of the whole or substantial part of the three dimensional works must amount to an infringement of the copyright in such three dimensional works under s 36 of the Act. In this instance, there is a direct infringement, as the three dimensional works themselves are protected under the Act.

I therefore answer Question 5 in the affirmative.

Enforcement

Question 6: Can the copyright owner of the copyright in such engineering drawings (two-dimensional) enforce his rights under the provisions of the Copyright Act 1987 in respect of such infringement under Question 4?

Here again, the defendant rely on the unanimous decision of the House of Lords in the *British Leyland* case[3] to say that the plaintiffs, as the copyright owners of the engineering drawings, cannot enforce their rights against

them following the latter's acts of reproducing the slurry pump parts and moulds through reverse engineering. They maintain that like the defendant in the English case, reproductions of the slurry pump parts and moulds constitute only reproductions of the functional parts of the slurry pump, for which the plaintiffs cannot maintain a monopoly in the supply of such spare parts.

British Leyland[3] can be distinguished in that it was a case on a two-dimensional work, namely, the engineering drawings of various car components exemplified by the exhaust system of the Marina car manufactured by British Leyland. Unlike our Copyright Act 1987, the English Copyright Act 1956 limits copyright to only two-dimensional works. There is no copyright in three-dimensional works under English law but there is an infringement by virtue of the extended definition of 'reproduction'. Thus it was held in *British Leyland*[3] that there was an infringement of the copyright in the engineering drawings when the defendant, Armstrong, copied their exhaust system by means of reverse engineering but because there is no copyright in the exhaust system, British Leyland could not sue the defendant for the infringement.

Another feature of the *British Leyand* case[3] is that it relied on the principle of non-derogation of grant, a concept of English land law which has not been imported into our Malaysian law.

As *British Leyland*[3] was decided on principles of law which are so different from ours, I cannot take recognition of the decision of that case to answer Question 6 in favour of the defendant.

On the other hand, applying the provisions of ss 3, 13 and 32 of the Act to the facts of the instant case before me, the plaintiffs, as the copyright owners of the engineering drawings, are entitled to enforce their rights under s 37 of the Act when the defendant infringed the copyright to the engineering drawings by reproducing identical slurry pump parts and moulds by way of reverse engineering.

For Question 6, I also give an affirmative answer.

Question 7: Can the copyright owner of the copyright in such three-dimensional works enforce his rights under the provisions of the Copyright Act 1987 in respect of such infringement under Question 5?

Following my conclusions that both the engineering drawings and the three-dimensional product thereof are eligible for protection, it follows that any infringement to any three-dimensional work by way of reproducing the whole or a substantial part through copying by way of reverse engineering, entitles the copyright owner to enforce his rights under s 37 of the Act.

I give a definite 'yes' to Question 7.

Copyright (Application To Other Countries) Regulations 1990.

Question 8: Having regard to the provisions of the Copyright (Application To Other Countries) Regulations 1990, can copyright subsist in work which is eligible for copyright under the provisions of the Copyright Act 1987, if the work originated from a specified country, although such work may not enjoy copyright protection under the laws of that specified country?

Under s 59A of the Act, the Minister charged with the responsibility for copyright matters, is empowered to make regulations applying any provisions of the Act to any country specified in the regulations. It was pursuant to this power, that the Copyright (Application To Other Countries) Regulations 1990 ('the Regulations') came into force on 1 October 1990.

Thus before 1 October 1990, copyright in literary, musical, artistic works, films, sound recordings, broadcasts and published editions that originate outside of Malaysia, do not enjoy copyright protection in Malaysia under the Malaysian Copyright Act 1987. It was only after 1 October 1990, that such protection was accorded but only to works that originate in countries which are members of the Berne Convention. Thus reference to 'specified countries' in the Regulations means countries which are members of the Berne Convention for the Protection of Literary and Artistic Works 1986. Both Australia, the home of the plaintiffs, and Malaysia are members of the Berne Convention and together with other member countries, they agreed under the Convention to the principle of reciprocity in the protection of the rights of authors in their literary and artistic works. This is expressed by art 5(1) of the Convention to read as follows:

> Authors shall enjoy, in respect of works for which they are protected under this Convention, in countries of the Union other than the country of origin, the rights which their respective laws do now or may hereafter grant to their nationals, as well as the rights specially granted by this Convention.

The protection afforded by the Convention is set out in art 3 and is applicable to:

(a) authors who are nationals of one of the countries of the Union, for their works, whether published or not;
(b) authors who are not nationals of one of the countries of the Union, for their works first published in one of those countries, or simultaneously in a country outside the Union and in a country of the Union.

Countries of the Union refer to the member countries of the Convention of which Australia and Malaysia are one.

Under art 5(2) of the Convention, the extent of the protection, apart from the provisions of the Convention, as well as the means of redress afforded to the author to protect his rights, shall be governed exclusively by the laws of the country where protection is claimed.

In this instance, the plaintiffs claim protection of their copyright in Malaysia and to that end, the Malaysian Copyright Act 1987 applies. Now the provisions of this Act have through the Regulations, been extended to Australia as well and by virtue of this, any specific work which originates in Australia which is eligible for copyright protection if such work had originated in Malaysia, would enjoy copyright protection even though the local laws of Australia do not accord such protection in such works.

This conclusion is emphasized by art 19 of the Convention which provides that the provisions of the Convention 'shall not preclude the making of a claim to the benefit of any greater protection which may be granted by legislation in a country of the Union'. The meaning of art 19 has been summed up by Staniforth Ricketson in his book *The Law of Intellectual Property* as follows:

A As protection in the country of origin is governed by domestic law, it is possible that an author may receive better protection in another member country, because the latter, apart from according him 'those rights specially granted by this Convention', confer a greater degree of protection upon its nationals under its domestic law and therefore upon him. It is specifically provided under art 19 that nothing in the Convention precludes this result.

B For the reasons that I have given, I again answer Question 8 in the affirmative.

Question 9: Does such a work described in para 8 above enjoy the rights and protection provided under the Copyright Act 1987?

C Since the Regulations of 1990 have extended the provisions of the Act to countries which are members of the Berne Convention, it follows that works from a specified country which do not enjoy copyright protection in their country of origin, nonetheless is vested with such protection under the Act and for that very reason I also answer this last question in the D affirmative.

All the nine questions have been posed to me pursuant to a consent order made under O 33 r 2 of the Rules of the High Court 1980, and since the plaintiffs have succeeded in obtaining affirmative answers to all nine questions, they contend that they are entitled to the costs of their application seeking the declaration of the issues raised by the nine questions. The E defendant, however, consider that costs should be costs in the cause, as the nine questions were only raised as preliminary issues and the trial of the whole suit has not yet commenced.

Whilst I accept that fact, it must be remembered that the determining of the issues posed by the nine questions was the means agreed by the parties F to avoid a long and protracted trial. Needless to say, the preliminary issues have been determined and they cannot be argued afresh at the trial unless, of course, my conclusions have been found to be incorrectly decided by the Supreme Court.

Despite this and going by the application made by the plaintiffs, where costs were to be provided for, and the consent order obtained on 20 August G 1992, where costs were to be determined after the issues raised on the nine questions have been determined, I consider that costs should follow the event and accordingly award costs to the plaintiffs in any event.

Order accordingly.

H Reported by Yap Foo Ken

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